

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re of Application of: John Walker
Application No.: 09/857,797 Group Art No.: 1644
Filed: September 13, 2001 Examiner: Yunsoo Kim
For: IMPROVED SAPONIN ADJUVANT COMPOSITIONS AND
METHODS RELATING THERETO
Confirmation No.: 9643
Customer Number: 25291

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Reply to Final Action and Request for Withdrawal of Finality

The present Reply is in response to the Official Action herein of December 3, 2009, made final, whereinby all claims under examination (Nos. 23-38) remain rejected. Reconsideration in view of the following remarks is respectfully requested.

Upon careful review of Applicant's Amendment of August 17, 2009, it is believed that all arguments therein are accurate and properly presented. As stated at Page 6 of Applicant's paper, it is believed that the Office is simply picking and choosing among individual fragments of information spread among many documents to reconstruct the present invention by hindsight, all the while the full teachings of the cited references are simply being disregarded.

At Page 5, lines 1-2, of the Official Action, the Examiner states "Further, Applicant's assertion that the combination of the references teaches away from the use of cholesterol is misleading". The Applicant stands behind its statements. Although the Applicant would be pleased to clarify any point for the Examiner, such is not possible at this time, since the Examiner has conspicuously failed to state with any particularity WHAT is misleading. Accordingly, the Office Action is actually incomplete and should be expanded and reissued with a new due date.

At Page 5, lines 2-3, the Official Action recites "Applicant has asserted that the '959 publication uses mineral oil as an essential adjuvant composition". Applicant has no idea why the Examiner has included only this one sentence in response to Applicant's obviously correct statement, since it relates to a key argument made by Applicant it is prior paper which the Examiner has failed to address. It seems that lines 2-3 of the Official Action should have been the starting point from which the Examiner would have then launched the needed discussion, but the discussion did not follow. As clearly set forth in Applicant's prior response, the '959 publication only relates to adjuvant compositions that must include 3 adjuvant components, one of which is mineral oil. There is no teaching in the '959 specification that if the essential mineral oil adjuvant is removed from the adjuvating compositions that the remaining ingredients would be meaningfully operable, and Applicant's arguments in this respect remain to be addressed.

Finally, Applicant's use of "consisting essentially of" in Claim 23 is believed to be precisely in accord with long standing practice and Page 2100-44/45 of MPEP section 2111.03. However, since other language forms are available and what Applicant intends is believed to be clear, and further given that Applicant is more than willing to work with the Examiner to define suitable replacement language, it seems that the Examiner should already have been on a position to advise on the patentability of the claim (over the art) in order to advance prosecution.

Applicant also respectfully disagrees with the Examiner's statement (bottom of Page 4) that the specification does not define what is encompassed by active components. It is reasonably believed that the adjuvant is specified in the specification and possible antigens are identified.

Date

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